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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,107	08/27/2001	Brian L. Klosterman	ST/037 CONT 2.	4286
7590	06/16/2006		EXAMINER	
Alexander Shvarts Fish & Neave 1251 Avenue of the Americas New York, NY 10020-1105			TRAN, HAI V	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/940,107	KLOSTERMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hai Tran	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 August 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>all</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alexander et al. (US 6177931).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 1, Alexander 02/28/2006er discloses a method for substituting alternative video and/or audio signals and/or graphics and/or text to be displayed on the viewer's television display monitor in the place of the video and/or audio signals

that would otherwise be displayed according to the channel to which the viewer has tuned the television set, the television set including an electronic program guide, the method comprising the steps of:

maintaining at a head end provider viewer profile data based user electronic program guide (Col. 29, lines 13-21);

monitoring at the head end provider an outgoing television signal for a first particular channel (Col. 34, lines 56-Col. 35, lines 26);

identifying the point in the outgoing television signal at which said signal begins carry advertising information (Col. 34, lines 56-Col. 35, lines 26);

inserting in said outgoing television signal on said first particular channel an instruction to any television that receives said television signal to change channels to a second particular channels (trigger; Col. 32, lines 27-Col. 33, lines 8 );

receiving the television signal at a viewer's television set on the 1<sup>st</sup> particular channel (Col. 26, lines 60-Col. 27, lines 2);

determining whether the television set is operating in an electronic program guide mode (TV channel that the viewer was watching immediately before entering the EPG; Col. 26, lines 60-Col. 27, lines 2);

tuning the viewer's television set to the 2<sup>nd</sup> particular channel (Ad channel/window) if the television set is operating in the electronic program guide mode (Col. 26, lines 60-Col. 27, lines 2); and

tuning the viewer's television set to the 1<sup>st</sup> particular channel (EPG channel).

Claim 2, wherein the instruction to change channels includes a duration of time and the television set is tuned to the 2<sup>nd</sup> particular channel for the duration of time (Col. 26, lines 64-Col. 27, lines 2).

Claim 3, wherein the 2<sup>nd</sup> channel is an advertisement information ((Col. 26, lines 64-Col. 27, line 2),

Claim 4, further comprising the step of displaying the advertisement information on a pre-determined portion of the EPG (Col. 26, lines 64-Col. 27, lines 2).

Claims 5 , the system claim is analyzed with respect to method claim 1.

Claim 6, the system claim is analyzed with respect to method claim 2.

Claim 7, the system claim is analyzed with respect to method claim 3.

Claim 8, the system claim is analyzed with respect to method claim 4.

Claim 9, the method claim is analyzed with respect to method claims 1 and 2.

Claim 10, the method further comprising collecting viewer profile data based on user interactions with the television system (Col. 28, lines 30-65).

Claim 11, the method further comprising transmitting the collected viewer profile data to the headend provider (Col. 29, lines 14-22).

Claim 12, the method wherein the instruction to change channels comprises instruction to change the selected advertisement channel (trigger; Col. 32, lines 27-Col. 33, lines 8);

Claim 13, further comprising: receiving a user command to change to a specific television channel (change to EPG) prior to the expiration of the duration of the advertisement carried by the selected advertisement channel (Col. 26, lines 60-67);

Tuning to the specific television channel; and remaining tuned to the specific television channel after the expiration of the duration of the advertisement (stay tune to EPG channel even thought Ads is expired; Col. 26, lines 56- Col. 27, lines 2).

Claim 14 is analyzed with respect to claim 4.

Claim 15, further comprising tuning to the particular television channel (EPG channel) at an expiration of the duration of the advertisement (Col. 26, lines 65-Col. 27, line 2).

Claims 16 and 22, the system claim is analyzed with respect to method claim 9.

Claims 17 and 23, the system claim is analyzed with respect to method claim 10.

Claim 18, the system claim is analyzed with respect to method claim 11.

Claim 19, the system claim is analyzed with respect to method claim 13.

Claims 20 and 24, the system claim is analyzed with respect to method claim 14.

Claims 21 and 25, the system claim is analyzed with respect to method claim 15.

Claim 22, 7, the system claim is analyzed with respect to method claim 3.

Claim 8, the system claim is analyzed with respect to method claim 4.

Claims 26, Alexander discloses a system for replacing television signals which perform the method as analyzed with claims 9-15 in which all components claimed, i.e. television receiver, tuner, display monitor and processor ... are inherently met by Alexander.

Claims 27-28, Alexander discloses a system for replacing television signals, which perform the method as, analyzed with claims 9-154 in which all components claimed, i.e. television receiver, tuner, display monitor and processor ... are inherently met by Alexander.

### ***Conclusion***

Art Unit: 2623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht  
06/09/2006

  
HAI TRAN  
PRIMARY EXAMINER